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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,824	07/31/2001	Frank Crupi	T8466250US	5851

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Gowling Lafleur Henderson LLP
Suite 4900
Commerce Court West
Toronto, ON M5L 1J3
CANADA

EXAMINER

ADDIE, RAYMOND W

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,824

Applicant(s)

CRUPI, FRANK

Examiner

Raymond W. Addie

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/31/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 3, 4 are objected to because of the following informalities:

Claim 3, Ins. 2-3, the phrase "connecting the blended intermediate to the entrance to the pick-up conveyor"; should be --moving the blended intermediate within the entrance of the pick-up conveyor--.

Claim 4, Ins. 2-3, the phrase "rotation about an axis perpendicular to the asphalt paved surface", should be --rotation about an axis orthogonal to the asphalt paved surface--; since the paved surface is 2 dimensional and the axis is normal or orthogonal to the plane of the surface. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cutler # 4,784,518 in view of Smith et al. # 5,114,267 in view of Strunk # 5,054,958.

Cutler discloses a method of in-situ rejuvenation of an asphalt surface (12), with an asphalt rejuvenation apparatus (10) including a pick-up conveyor (40), comprising the steps of:

Heating the asphalt paved surface (28) to form a heated asphaltic material (52).

Milling the scarified, intermediate, heated asphaltic material to form a milled, scarified, heated intermediate asphaltic material.

Blending rejuvenating fluid with the milled, scarified, intermediate asphaltic material, to form a blended, milled, scarified intermediate asphaltic material.

Moving the blended, milled, scarified, intermediate asphaltic material to an entrance of the pick-up conveyor. See col. 2, ln. 36-col. 3, ln. 7; col. 4, ln. 40-col. 5, ln. 40.

What Cutler does not disclose is a method to repave a roadway having at least one imbedded obstruction, such as a manhole.

However, Smith et al. recognizes a problem associated with imbedded roadway obstructions and teaches a roadway paver having an adjustable windrow pick-up capability, to accommodate repaving roadways having imbedded obstructions, such as a manhole shaft. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the method of repaving a roadway, with the step of providing a paver with an adjustable windrow pick-up assembly, as taught by Smith et al., in order to accommodate obstructions in a roadway during repaving. See Smith et al. col. 1, lns. 14-col. 2, ln. 65.

What Smith et al. does not teach is providing a back-hoe apparatus to the end of the pick-up conveyor. However, Strunk teaches a roadway construction apparatus comprising:

A pick-up conveyor (20) having a backhoe apparatus (34) for feeding roadway construction material into the pick-up conveyor for recycling into a prepared roadway. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the method of repaving a roadway, of Cutler in view of Smith et al., with the step of moving a roadway construction material from a surface being prepared, via a back-hoe device, as taught by Strunk, in order to efficiently recycle the paving material into a new road surface, as taught by Strunk and reasonably suggested by Smith et al., See Smith et al. col. 2, Ins. 16-23; Strunk col. 4, In. 33-col. 5, In. 9.

In regards to claim 2 Cutler discloses the blended intermediate asphaltic material (52) is deposited onto the roadway in a uniform continuous manner; but does not disclose the method of depositing the blended intermediate behind the obstruction. Smith et al. teaches it is known that imbedded roadway obstructions, such as manhole shafts, are often covered and hidden from view when windrowing a recycled paving material. Hence, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, that the method of repaving a roadway of Cutler, would include the step of depositing a heated, scarified, milled and blended intermediate asphaltic material on a roadway, having at least one obstruction, such as a manhole shaft, as taught by Smith et al., in order to form a windrow, that can be collected and spread by a paving machine. See Cutler Col. 2, Ins. 35-50; Smith et al. col. 2, Ins. 16-33.

In regards to Claims 3, 4, 9-12 Cutler in view of Smith et al. disclose a method of repaving a roadway comprising heating, scarifying, milling and blending an asphaltic roadway and redepositing the material back onto the roadway. Cutler in view of Smith et al. do not disclose using a back-hoe to feed paving material into a pick-up conveyor. However, Strunk teaches providing a back-hoe, rotatably mounted to a roadway rejuvenating apparatus, for rotation about a vertical axis so that the back hoe can move laterally, relative to the roadway, and hence avoid any obstruction and move paving material disposed on the roadway, proximate the entrance of the pick-up conveyor (20) for further processing and recycling into the roadway. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to provide the method of repaving a roadway of Cutler with the method step of moving a back-hoe device, laterally in order to convey a roadway construction material toward an entrance to a pick-up conveyor, as taught by Strunk, in order to process the construction material for recycling into the roadway.

In regards to Claim 5, Cutler in view of Smith et al. disclose it is desirable to provide a paving machine with a pick-up conveyor, for removing paving material from a roadway. What Cutler in view of Smith et al do not disclose is mounting a backhoe apparatus to the conveyor housing. Strunk teaches mounting a backhoe to the frame of the paving apparatus at (44) and adjacent the conveyor housing (20). Strunk further teaches the backhoe can be used to move roadway construction material from the roadway surface,

and adjacent the roadway, and for placing roadway construction material in front, or in the pick-up conveyor said roadway material. Hence, it would have been obvious to mount the backhoe device to the conveyor housing, since the conveyor housing is part of the machine frame. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the method of repaving a roadway of Cutler in view of Smith et al., with the method step of mounting a back hoe apparatus on a paving machine, as reasonably suggested by Strunk, in order to move roadway paving material from the roadway into the pick-up conveyor.

See Strunk Col. 4.

In regards to Claims 8, 15 Cutler discloses the asphalt rejuvenating apparatus comprises: A plurality of heaters (30, 32) that heat the asphalt roadway.

A raking device (34) dislodges the heated asphalt to form a scarified intermediate (38).

A plurality of mill cutters (56) in the form of a 1st main mill which grinds the scarified intermediate to form a milled intermediate.

A 2nd mill (56) for mixing a rejuvenating fluid with the milled intermediate to form a blended intermediate.

In regards to Claims 16, 17 Cutler discloses a method of in-situ rejuvenation of an asphalt-paved surface (12) with an asphalt rejuvenating apparatus (10) including a pick-

conveyor (40) comprising the steps of:

Heating the asphalt paved surface (28).

Scarifying the heated asphalt to form a scarified, intermediate-asphaltic material (38).

Milling the heated asphalt to form a milled intermediate. What Cutler does not disclose is a roadway have an imbedded obstruction, such as a manhole.

However, Smith et al. teaches that problems exist when repaving roadways having at least one imbedded obstruction, and teaches a roadway paver having an adjustable windrow pick-up conveyor can accommodate imbedded obstructions when repaving roadways. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the method of repaving a roadway of Cutler, with the step of providing a paving machine with an adjustable pick-up conveyor, as taught by Smith et al., in order to avoid damaging the paving machine during paving processes. What Cutler in view of Smith et al. does not teach is providing a back-hoe device to the pick-up conveyor. However, Strunk teaches a roadway construction apparatus comprising: A pick-up conveyor (20) having a backhoe apparatus (34) for feeding roadway construction materials into the pick-up conveyor for recycling into the prepared roadway. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to provide the method of repaving a roadway having an obstruction, of Cutler in view of Smith et al., with the step of moving paving material to an entrance to a pick-up conveyor, utilizing a backhoe device, as taught by

Strunk, in order to efficiently recycle and repave a roadway. See Smith et al. col. 2, Ins. 16-23; Strunk col. 4, Ins. 33-col. 5, In. 9.

Response to Amendment

3. Applicant's amendments to claims 3, 4, 8 have overcome the 35 U.S.C. 112 2nd paragraph rejection, put forth in the 1st Office Action.

Response to Arguments

4. Applicant's arguments filed 4/13/2004 have been fully considered but they are not persuasive. Applicant argues "the combination of Cutler, Smith et al. and Strunk do not result in the combination of elements comprising the claimed invention in Claim 1.

However, the Examiner does not concur.

Firstly, Claim 1 is a method claim not an apparatus claim, hence there is no "combination of elements" that comprises the claimed invention in claim 1.

Further, Cutler the primary reference discloses all the claimed method steps, except for moving the blended intermediate to an entrance of a pick-up conveyor with a backhoe apparatus. However, such is taught by Strunk.

Applicant further argues "Strunk does not teach a person of ordinary skill in the art to use a backhoe apparatus to feed roadway construction material into a pick-up conveyor for recycling into the prepared roadway"; and that "none of the material excavated by the backhoe assembly is of a roadway construction material quality".

However, Applicant contradicts these statements by stating "Recycling of existing asphalt road surfaces into a prepared roadway in this manner is specifically described in Strunk".

Further, Strunk positively recites "A conveyor connected to the scoop transports the material from the scoop to a rock crusher...The rock crusher reduces the size of the rock and deposits the crushed rock back on the road bed". Strunk further teaches "an alternate embodiment of the leading edge may have chip breakers to tear up existing asphaltic pavements". Still further Strunk teaches "the excavator bucket assembly is used to remove overburden not accessible to scoop (20)".

Hence, it is obvious that the pick-up conveyor can be adapted for use in recycling existing asphaltic roadways and the bucket assembly is used to remove overburden not accessible to scoop (20); which in the case of recycling an existing asphaltic roadway, the overburden would in fact be asphaltic material removed from the existing roadway. See col. 4, Ins. 4-35.

Therefore, the argument is not persuasive and the rejection is upheld.

In regards to Claims 1, 16, 17 Applicant then argues "Because Strunk's backhoe apparatus is not provided for "feeding roadway construction material (sin) the pick-up conveyor for recycling into the prepared roadway the Applicant submits that Strunk's backhoe combined with the teachings of Cutler and Smith et al. does not disclose all of the elements of the invention".

Applicant then suggests "Strunk does not contemplate using his backhoe apparatus for the purpose of feeding roadway construction to a pick-up conveyor".

However, the recitation "for feeding roadway construction material in the pick-up conveyor for recycling into the prepared roadway" is clearly an intended use of the device, which is clearly disclosed by Strunk. In Col. 2, Ins. 31-36 recite "The bucket assembly is used to excavate the overburden and to deposit the material in the scoop". Strunk further teaches the machine can be used to recycle an existing asphaltic roadway. Hence, the overburden disclosed in the alternative embodiment would in fact be asphaltic roadway construction materials.

Therefore, the argument is not persuasive and the rejection is upheld.

Finally, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Applicant attacked the tertiary reference to Strunk and made no direct arguments against the primary and secondary references to Cutler and Smith et al., respectively.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

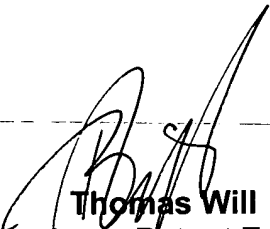
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond W. Addie whose telephone number is 703 305-0135. The examiner can normally be reached on 8-2, 6-8.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3671

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas Will
Supervisory Patent Examiner
Group 3600

RWA
7/2/04